RECEIVED
CENTRAL FAX CENTER
JUL 18 2006

In re Application of SUTTON et al.
Serial No. 10/075,633

REMARKS

The Office action has been carefully considered. The Office action rejected claims 1-4, 6-8, 10-13, 17, 19, 20-21, and 23-35 under 35 U.S.C. § 103(a) as being unpatentable over U.S. Patent No. 6,728,748 B1 to Mangipudi et al. ("Mangipudi") in view of U.S. Patent No. 6,701,323 B2 to Sashino et al. ("Sashino") and in further view of U.S. Patent No. 6,839,723 to Sugimoto et al. ("Sugimoto"). Further, the Office action rejected claims 5 and 9 under 35 U.S.C. § 103(a) as being unpatentable over Mangipudi in view of Sashino and Sugimoto and in further view of and U.S. Patent No 5,987,504 to Toga et al. ("Toga"). Further yet, the Office action rejected claim 14 under 35 U.S.C. § 103(a) as being unpatentable over Mangipudi in view of Sashino and Sugimoto and in further view of U.S. Patent No 6,839,723 to Choquier et al. ("Choquier"). Still further, the Office action rejected claim 15 under 35 U.S.C. § 103(a) as being unpatentable over Mangipudi in view of Sashino and Sugimoto and in further view of U.S. Patent No 6,789,105 B2 to Ludwig et al. ("Ludwig"). Still further yet, the Office action rejected claims 16, 18, 38 and 40 under 35 U.S.C. § 103(a) as being unpatentable over Mangipudi in view of Sashino and Sugimoto and in further view of *Exotica: A Project on Advanced Transaction Management and Workflow System* by C. Mohan. ("Mohan"). The Office action rejected claim 41 under 35 U.S.C. § 103(a) as being unpatentable over Mangipudi in view of Sashino, Sugimoto, and Mohan and in further view of U.S. Patent No 5,978,381 to Perlman et al. ("Perlman"). The Office action rejected claims 42-47 under 35 U.S.C. § 103(a) as being unpatentable over U.S. Patent No. 6,125,394 to Rabinovich et al. ("Rabinovich") in view of Mangipudi and in further

view of U.S. Patent No. 6,324,580 B1 to Jindal et al. ("Jindal"). The Office action rejected claim 48 under 35 U.S.C. § 103(a) as being unpatentable over Rabinovich in view of Mangipudi and Jindal and in further view of Sugimoto. Finally, the Office action rejected claims 22, 36-37, and 39 under 35 U.S.C. § 103(a) as being unpatentable over Mangipudi in view of Sashino, Sugimoto and Rabinovich. Applicants respectfully disagree.

By present amendment, claims 1, 17, 25, 38, and 42 have been amended for clarification and not in view of the prior art. Applicants submit that the claims as filed were patentable over the prior art of record, and that the amendments herein are for purposes of clarifying the claims and/or for expediting allowance of the claims and not for reasons related to patentability. Reconsideration is respectfully requested.

Prior to discussing reasons why applicants believe that the claims in this application are clearly allowable in view of the teachings of the cited and applied references, a brief description of the present invention is presented.

The present invention is directed to a multiple device management method and system. The system may include a mechanism to execute a single command on one controller computer that may then invoke actions on one or more other controlled computers, typically referred to as nodes. An operation may comprise the execution of a scripted set of commands, execution of a binary program, or a number of other types of operations. The mechanism may work with unique sets of computers as if they were a single computer, whereby, for example, management of computing devices is greatly simplified, and the cost of managing computing

devices in a data center is significantly reduced. Each unique set may comprise various nodes or devices that are differentiated by their operational capability.

In one implementation, the present invention may provide an architecture comprising a controller on one computer that may manage multiple other computers, each containing agent software allowing each respective controlled computer to be managed by the controller. In general, the controller provides a central representation of the multiple nodes it manages, from which actions can be initiated against the nodes, which may be selected individually or by sets to which the nodes may be assigned. The controller may communicate with the nodes using a messaging format, such as one derived from XML (eXtensible Markup Language), using a replaceable underlying transport layer for network communication.

In this manner, the controller may provide a defined way to represent available nodes in a data center, their organization into sets, and the results of ongoing and completed operations. For example, a schema may be used to persist the representation of the available nodes, and sets of nodes (*e.g.*, as grouped together by an administrator typically according to some criterion, such as administrative convenience, operational purposes or other criteria). The schema may also be used to store a record of the results of each action on a storage device accessible to the controller, along with pending and performed operations, and jobs.

Note that the above description is for example and informational purposes only, and should not be used to interpret the claims, which are discussed below.

Turning to the claims, claim 1 generally recites a method in a computer network, comprising, maintaining a plurality of unique sets at a controller, each set differentiated by operational capability and comprising a grouping of at least one computing device, providing at the controller a job corresponding to at least one operation to perform on the selection, providing at the controller a job corresponding to at least one operation to perform on the selection, sending a message from the controller to each computing device in the selection, the message instructing the computing device that receives the message to execute the job, and at the controller, storing results of the job from each computing device in the selection.

The Office action rejected claim 1 under §103(a) as being unpatentable over Mangipudi in view of Sashino and in further view of Sugimoto. More specifically, the Office action contends that Mangipudi teaches a controller (referencing the TCP Router at column 4, lines 36-40/51-56 and column 7, lines 55-60 of Mangipudi), a plurality of unique sets, (referencing Gold, Silver, and Bronze at column 7, lines 30-40 of Mangipudi), a set comprising a grouping of at least one computing device (referencing column 7, lines 35-40 of Mangipudi), maintaining at least one set at the controller (referencing column 7, lines 13-20/55-60 and column 10, lines 40-50 of Mangipudi), providing at the controller a selection corresponding to at least one computing device (referencing column 9, lines 35-40/65-67 and column 10, lines 1-5/40-45 of Mangipudi).

The Office action concedes that Mangipudi fails to teach providing at the controller, a job corresponding to at least one operation to perform on the selection,

sending a message from the controller to each computing device in the selection, the message instructing the computing device that receives the message to execute the job, and at the controller, storing results of the job from each computing device in the selection. However, the Office action contends that Sashino does teach providing at the controller, a job corresponding to at least one operation to perform on the selection (referencing column 5, lines 49-50 and column 10, lines 59-54 of Sashino), sending a message from the controller to each computing device in the selection, the message instructing the computing device that receives the message to execute the job (referencing column 8, lines 6-10, column 3, lines 50-55, and column 10, lines 38-41 of Sashino).

Further, the Office action contends that Sugimoto does teach storing results of the job from each computing device in the selection (referencing column 12, lines 12-15). The Office action concludes that it would have been obvious to a person skilled in the art at the time of the invention to have combined the teachings of Mangipudi, Sashino, and Sugimoto because Sugimoto's store feature would provide flexibility to Mangipudi's and Sashino's systems by allowing users to save information for use later. Applicants respectfully disagree.

To establish *prima facie* obviousness of a claimed invention, all of the claim recitations must be taught or suggested by the prior art; (*In re Royka*, 490 F.2d 981, 180 USPQ 580 (CCPA 1974)), and "all words in a claim must be considered in judging the patentability of that claim against the prior art;" (*In re Wilson*, 424 F.2d 1382, 1385, 165 USPQ 494, 496 (CCPA 1970)). Further, if prior art, in any material respect teaches away from the claimed invention, the art cannot be used

to support an obviousness rejection. *In re Geisler*, 116 F.3d 1465, 1471, 43 USPQ2d 1362, 1366 (Fed Cir. 1997). Moreover, if a modification would render a reference unsatisfactory for its intended purpose, the suggested modification / combination is impermissible. See MPEP § 2143.01.

Applicants submit that the Office action has failed to establish a *prima facie* case for obviousness. The cited and applied references still represent a mismatch of essentially non-analogous prior art with little correlation to each other, from which the Office action merely picks out phrases as examples for an obviousness argument. Furthermore, as detailed below, the references simply do not teach all of the limitations of the claims.

For example, with respect to claim 1, the cited and applied references do not teach applicants' invention as claimed. Mangipudi is directed, generally, to a method and system for providing flexible privilege-based access to various services available from a domain (or server or enterprise, *etc.*). In this system, a front-end processor (such as a TCP router) is configured to receive all client service requests or site requests. Then, based on the class of the request (*e.g.*, the user) and also based on the current load of various back-end servers (*e.g.*, traffic for a requested web page), the TCP router is able to make a decision to route the request to a specific back-end server. Further, Mangipudi describes grouping specific back-end servers into clusters for handling requests (*e.g.*, Gold, Silver and Bronze) such that higher traffic web sites will be assigned more back-end servers. That is, important traffic will go to a gold group comprising five identical servers, less-important requests will go to a silver group comprising three

identical servers, and the least important traffic will be routed to a bronze group that is a single back-end server. These back-end servers, however, are not differentiated from each other by any operational capability, but rather solely upon an initial group assignment. For example, in Mangipudi, gold-option traffic has five servers to handle requests while bronze-option traffic only has one server to deal with the requests.

Thus, if one were to follow a typical request for a web page through the system of Mangipudi, a request is received at a TCP router and sent to one back-end server that may be among several groupings of back-end server. The particular back-end server will depend on the importance of the request. Once sent to a back-end server, the request and subsequent traffic is dealt with directly between the back-end server and the client that is requesting. At no time does any traffic flow back through the TCP router, nor is anything stored at the TCP router. This is one significant difference between Mangipudi and the plain language of claim 1.

With regard to claim 1, the Office action cites Mangipudi as an example of prior art that teaches a controller coupled to nodes which represent computing devices, *i.e.*, the first three limitations of claim 1. However, claim elements cannot be interpreted in a vacuum and are afforded the context by which the entire claim reads as a whole. Merely picking and choosing various prior art elements to construct an obviousness rejection is not permissible at law. While Mangipudi may teach the use of a TCP router that is able to direct traffic and requests among a plurality of replicated servers that are pre-grouped into gold, silver, and bronze

farms, this cannot be fairly construed to suggest a controller capable of differentiating unique sets of devices based upon operational capability. That is, in the present invention, a differentiation between unique sets is simply not differentiated by a number of servers assigned to a group (*i.e.*, 5 for gold, 3 for silver, *etc.* as taught by Mangipudi). Rather, each unique set comprises various computing devices that are differentiated by their actual operational and performance capabilities. With such a system, not only may traffic be routed intelligently, but further, specific jobs may be routed intelligently. For example, data streaming may be routed to a unique set of devices better suited for data streaming, while simple URL requests may be routed to the unique set of devices most suited for web hosting. As a result, differentiating each set based upon operational capability results in a controller being able to intelligently route all jobs received, and store returned data about these jobs.

The Office action concedes that Mangipudi does not teach a controller that can direct actual jobs. Even if one were to somehow construe Mangipudi as teaching or suggesting the ability for the TCP router to handle job requests, the fact remains that the TCP router cannot differentiate any set of devices based upon the sets' operational capabilities. In fact, no other prior art of record addresses this plainly-recited limitation.

Notwithstanding, the Office action has pasted together disparate sections of three disparate references in an (unsuccessful) attempt to show obviousness and allege some motivation to combine references. However, instead of considering the language of claim 1 in its fair context, the Office action merely picks out

phrases from applicants' recitations and cites various references as allegedly prior art. This is clearly impermissible hindsight based solely on applicants' teachings; as a matter of law, obviousness may not be established using hindsight obtained in view of the teachings or suggestions of the applicants. *W.L. Gore & Assocs., Inc. v. Garlock, Inc.*, 721 F.2d 1540, 1551, 1553, 220 USPQ 303, 311, 312-13 (Fed. Cir. 1983), cert. denied, 469 U.S. 851 (1984). To guard against the use of such impermissible hindsight, obviousness needs to be determined by ascertaining whether the applicable prior art contains any suggestion or motivation for making the modifications in the design of the prior art article in order to produce the claimed design. The mere possibility that a prior art teaching could be modified or combined such that its use would lead to the particular limitations recited in a claim does not make the recited limitation obvious, unless the prior art suggests the desirability of such a modification. *See In re Gordon*, 733 F.2d 900, 902, 221 USPQ 1125, 1127 (Fed. Cir. 1984).

A mere statement that modifications of the prior art to meet the claimed invention would have been "well within the ordinary skill of the art at the time the claimed invention was made" is not sufficient to establish a *prima facie* case of obviousness without some objective reason to combine the teachings of the references. *Ex parte Levengood*, 28 USPQ2d 1300 (Bd. Pat. App. & Inter. 1993). The mere fact that references can be combined or modified does not render the resultant combination obvious unless the prior art also suggests the desirability of the combination. *In re Mills*, 916 F.2d 680, 16 USPQ2d 1430 (Fed. Cir. 1990). Instead of meeting this burden, the Office action has simply pieced together

language from unrelated references, e.g., Mangipudi's router, an example of sending a message that may cause execution of a job (Sashino), and an example of storing returned messages (Sugimoto). This is insufficient to support an obviousness holding as a matter of law.

Applicants submit that claim 1 is allowable over the prior art of record for at least these reasons.

Applicants respectfully submit that dependent claims 2-4, 6-8, and 10-13, by similar analysis, are allowable. Each of these claims depends either directly or indirectly from claim 1 and consequently includes the recitations of independent claim 1. As discussed above, Mangipudi, Sashino, and Sugimoto, whether considered alone or in any permissible combination at law, fail to teach or suggest the recitations of claim 1 and therefore these claims are also allowable over the prior art of record. In addition to the recitations of claim 1 noted above, each of these dependent claims includes additional patentable elements.

The Office action rejected claims 5 and 9 as being unpatentable over the combination of the teachings of Mangipudi, Sashino, Sugimoto, and Toga. Applicants again maintain that a *prima facie* case for obviousness has not been established. Rather, the same fallible argument is presented wherein yet another reference (Toga) is cited as allegedly teaching a phrase of the claim language (using a network address) but at the very least lacks the motivation to be combined with other references. As discussed above, Mangipudi, Sashino, and Sugimoto, whether considered alone or in any permissible combination at law, fail to teach or suggest the recitations of claim 1 and therefore these claims are also allowable

motivation for combining the prior art of record. Applicants submit that claims 14, 15, and 16 are allowable over the prior art for at least these reasons.

Turning to the next independent claim, amended claim 17 recites in a computer network, a data structure comprising a schema, the schema configured to enable a plurality of unique sets of computing nodes differentiated by operational capability to be controlled by a controller computer, the schema including a plurality of device objects, each device object identifying a computing node capable of being controlled by the controller, at least one set object, each set object identifying a group of at least one computing node identified by a device object, and a job object, the job object specifying data corresponding to an operation to be executed by each computing node grouped together via a set object.

The Office action rejected claim 17 as unpatentable over Mangipudi in view of Sashino and in view of Sugimoto. Specifically, the Office action contends that Mangipudi teaches a controller (citing a TCP router described in column 4, lines 36-40/51-56 and column 7, lines 55-60 of Mangipudi), a plurality of computing nodes (referencing Gold, Silver, and Bronze at column 7, lines 30-40 of Mangipudi), a schema citing selectable load distribution described at column 4, lines 53-56 of Mangipudi), and a set object, the set object specifying data corresponding to an operation to be executed (citing column 7, lines 52-54 of Mangipudi).

The Office action acknowledges that Mangipudi does not teach each device object identifying a computing node capable of being controlled by the controller, or a schema wherein the schema is configured to enable a plurality of computing

over the prior art of record. Simply citing Toga does not remedy the shortcomings of the teachings of the prior art of record nor provides any motivation whatsoever for combining the prior art of record. Applicants submit that claims 5 and 9 are allowable over the cited prior art for at least these reasons.

The Office action rejected claim 14 as being unpatentable over the combination of the teachings of four references, namely Mangipudi, Sashino, Sugimoto, and Chocquier. The Office action also rejected claim 15 as being unpatentable over the combination of the teachings of Mangipudi, Sashino, Sugimoto, and Ludwig. Further, the Office action rejected claim 16 as being unpatentable over the combination of the teachings of Mangipudi, Sashino, Sugimoto, and Mohan. Applicants again maintain that a *prima facie* case for obviousness has not been established for each of these rejections. Rather, the same fallible argument is presented wherein yet another reference (Chocquier for claim 14, Ludwig for claim 15, and Mohan for claim 16) is cited as allegedly teaching a phrase of applicants' claim language (setting a threshold level as recited in claim 14, storing data in a storage as recited in claim 15, and persisting data as recited in claim 16) but lacks the motivation to be combined with other references. As discussed above, Mangipudi, Sashino, and Sugimoto, whether considered alone or in any permissible combination at law, fail to teach or suggest the recitations of claim 1 and therefore these dependent claims are also allowable over the prior art of record. Simply citing Chocquier, Ludwig, or Mohan does not remedy the shortcomings of the teachings of the prior art of record nor provides any

nodes to be controlled by a controller computer, such that the schema includes a plurality of device objects. However, the Office action contends that Sashino does teach these recitations and cites column 2, lines 50-55, column 4, lines 40-56, and column 10, lines 59-64 of Sashino. There is no reference to Sugimoto in the rejection of claim 17. Apparently, the Office action then concludes that the recitations of claim 17 would have been obvious to a person skilled in the art at the time the invention was made because the teachings of Sashino would improve the system of Mangipudi despite not identifying any motivation to combine these references. Applicants respectfully disagree.

Applicants submit that the Office action has failed to establish a *prima facie* case of obviousness. As discussed above regarding claim 1, the cited and applied references represent a mismatch of essentially non-analogous prior art with little correlation to each other, from which the Office action in a purely impermissible hindsight reconstruction of applicants' invention merely picks out phrases as alleged examples for an obviousness argument. Furthermore, the Office action has simply not given any citation or reasoning as to why Mangipudi and Sashino may be combined in the manner suggested, how to do so, or what might be accomplished by such a combination.

More specifically with regard to claim 17, the cited and applied references do not teach applicants' invention as claimed. Instead of fairly considering the words of claim 17, the Office action merely relies on phrases from applicants' recitations, and using applicants' teachings as a guide, cites various references as allegedly prior art.

In addition to the reasons discussed above, applicants submit that the prior art of record fails to teach or suggest maintaining a plurality of sets at a controller, each set comprising a grouping of at least one computing device. The Office action apparently was persuaded by this argument in a previous Office action response, given that Mangipudi was introduced with regard to each of the other independent claims, but for claim 17.

Notwithstanding these clear differences, claim 17 has been amended to recite a schema configured to enable a plurality of unique sets of computing nodes differentiated by operational capacity to be controlled by a controller computer. The Office action has characterized a schema taught by Sashino as disclosing this recitation. Simply reciting the word schema doers not teach a particular schema for accomplishing a particular arrangement of data. Sashino does not teach a schema configured to enable a plurality of unique sets of computing nodes differentiated by operational capability to be controlled by a controller computer. Furthermore, as already pointed out, no prior art of record teaches a plurality of sets of computer nodes wherein the sets of computer nodes are unique and differentiated by operational capacity. Simply put, the prior art of record, in any permissible combination at law, does not teach or suggest the recitations of clam 17 and applicants submit that for at least the foregoing reasons that claim 17 is allowable over the prior art of record.

Applicants respectfully submit that dependent claims 19-24, by similar analysis, are allowable. Each of these claims depends either directly or indirectly from claim 17 and consequently includes the recitations of independent claim 17.

As discussed above, Mangipudi, Sashino, and Sugimoto, whether considered alone or in any permissible combination at law, fail to teach or suggest the recitations of claim 17, and therefore these dependent claims are also allowable over the prior art of record. In addition to the recitations of claim 17 noted above, each of these dependent claims includes additional patentable elements.

The Office action rejected claim 18 as being unpatentable over the combination of the teachings of Mangipudi, Sashino, Sugimoto, and Mohan. Applicants again maintain that a *prima facie* case for obviousness has not been established. Rather, the same fallible argument is presented wherein yet another reference (Mohan) is cited as teaching a phrase of applicants' claim language (persisting data), but even to the extent the phrase may correspond, there is simply no motivation in the prior art of record or elsewhere to combine Mohan with the other references. As discussed above, Mangipudi, Sashino, and Sugimoto, whether considered alone or in any permissible combination at law, fail to teach or suggest the recitations of claim 17, and therefore dependent claim 18 is also allowable over the prior art of record. Simply citing a phrase in Mohan does not remedy the shortcomings of the teachings of the prior art of record nor provides motivation for combining the prior art of record. Applicants submit that claim 18 is allowable over the prior art for at least these reasons.

Turning to the next independent claim, amended claim 25 recites in a computer network, a system, comprising a controller, the controller configured to receive a selection corresponding to at least one node among a plurality of unique nodes that are differentiated by operational capability, a node identified in the

selection, the node including agent software connected for communication with controller software on the controller, a job maintained by the controller, the job corresponding to at least one operation to perform on the selection, a transport configured to communicate a message containing data corresponding to the job from the controller software to the agent software of the node, the message instructing the agent software to execute the job, the agent software of the node executing the job and returning results to the controller in response to receiving the message, and a data store at the controller, the controller storing the results from the agent software in the data store.

The Office action rejected claim 25 as unpatentable over Mangipudi in view of Sashino and in further view of Sugimoto. Specifically, the Office action cites the same rationale for the rejection of claim 25 as was discussed above with respect to the rejections of claim 1. Applicants respectfully disagree.

Applicants reiterate that the Office action has failed to establish a *prima facie* case for obviousness. As discussed above regarding claims 1 and 17, the cited and applied references represent a mismatch of unrelated prior art with little correlation to each other, from which the Office action has merely picked out some phrases to allege obviousness. More specifically with regard to claim 25, the cited and applied references do not teach applicants' invention as claimed. Instead of considering all of the words of claim 25, the Office action merely uses applicants' teachings and claim element recitations as a guide to cite various references as allegedly prior art.

In addition to the reasons discussed above regarding claims 1 and 17, applicants submit that the prior art of record fails to teach or suggest a controller configured to receive a selection corresponding to at least one node among a plurality of nodes that are differentiated by operational capability. Mangipudi only teaches a set of resources that are replicas of each other, whether they be grouped in numbers of one, three, or five. Groups of replicated servers are certainly not differentiated by operational capability. Applicants submit that claim 25 is allowable over the prior art of record for at least these reasons.

Applicants respectfully submit that dependent claims 26-37, by similar analysis, are allowable. Each of these claims depends either directly or indirectly from claim 25 and consequently includes the recitations of independent claim 25. As discussed above, Mangipudi, Sashino, and Sugimoto, whether considered alone or in any permissible combination at law, fail to teach or suggest the recitations of claim 25 and therefore these claims are also allowable over the prior art of record. Even if somehow permissible to introduce the teachings of Rabinovich, as is contended in the rejection of claims 36 and 37, the mere combination of yet another reference still fails to teach or suggest the recitations of claims 36 and 37 no matter the permissible combination at law. In addition to the recitations of claim 25 noted above, each of these dependent claims includes additional patentable elements.

Turning to the next independent claim, amended claim 38 recites in a computer network, a method comprising selecting, as a selected set among a plurality of unique sets differentiated by operational capability, a set comprising a

plurality of computing devices, and instructing a controller to perform an operation to the set, the controller communicating with each computing device in the set to request performance of the operation and receive a result of the requested operation, the controller logging the result.

The Office action rejected claim 38 as unpatentable over another set of four references, namely Mangipudi in view of Sashino and Sugimoto and in further view of Mohan. Specifically, the Office action cites the same rationale for the rejection of claim 25 as was discussed above with respect to the rejections of claim 1. Applicants respectfully disagree.

Applicants submit that the Office action has failed to establish a *prima facie* case for obviousness. As discussed above regarding claims 1, 17, and 25, the cited and applied references represent a mismatch of prior art with little correlation to each other, from which the Office action picks out some phrases to try to support an obviousness argument. More specifically with regard to claim 38, the cited and applied references do not teach applicants' invention as claimed. Instead of considering all of the words of claim 38, the Office action merely uses phrases from applicants' recitations and cites various references as allegedly prior art.

Mangipudi is merely an example non-analogous system for applying a priority processing algorithm to a server farm of server systems that are replicated. Replicated servers, even if grouped together and named by grouping are certainly not differentiated by operational capability. The solution taught by Mangipudi is directed to an entirely different problem than that which is solved by the present invention.

Furthermore, applicants maintain that the Office action is clearly employing impermissible hindsight reasoning based on applicants' teachings to arrive at its obviousness conclusions. As a matter of law, obviousness may not be established using hindsight obtained in view of the teachings or suggestions of the applicants. *W.L. Gore & Assocs., Inc. v. Garlock, Inc.*, 721 F.2d 1540, 1551, 1553, 220 USPQ 303, 311, 312-13 (Fed. Cir. 1983), cert. denied, 469 U.S. 851 (1984). To guard against the use of such impermissible hindsight, obviousness needs to be determined by ascertaining whether the applicable prior art contains any suggestion or motivation for making the modifications in the design of the prior art article in order to produce the claimed design. The mere possibility that a prior art teaching could be modified or combined such that its use would lead to the particular limitations recited in a claim does not make the recited limitation obvious, unless the prior art suggests the desirability of such a modification. *See In re Gordon*, 733 F.2d 900, 902, 221 USPQ 1125, 1127 (Fed. Cir. 1984). Such references, wholly unrelated to one another as well as to the claimed invention, clearly do not suggest such a modification / combination.

Applicants respectfully submit that dependent claims 39-40, by similar analysis, are allowable. Each of these claims depends directly from claim 38 and consequently includes the recitations of independent claim 38. As discussed above, Mangipudi, Sashino, Sugimoto, and Mohan whether considered alone or in any permissible combination at law, fail to teach or suggest the recitations of claim 38 and therefore these dependent claims are also allowable over the prior art of

record. In addition to the recitations of claim 38 noted above, each of these dependent claims includes additional patentable elements.

The Office action rejected claim 41 as being unpatentable over the combination of the teachings of even more *(five!)* references, namely Mangipudi, Sashino, Sugimoto, Mohan, and Perlman. Applicants again maintain that a *prima facie* case for obviousness has not been established. Rather, the same flawed argument is basically presented but with yet another reference (Perlman) cited as teaching a phrase of applicants' claim language (storing data in a storage and retrying failed operations). There is simply no supportable motivation for combining these references as required by law. As discussed above, Mangipudi, Sashino, Sugimoto, and Mohan whether considered alone or in any permissible combination at law, fail to teach or suggest the recitations of claim 38 and therefore dependent claim 41 is also allowable over the prior art of record. Simply citing Mohan and Perlman does not remedy the shortcomings of the teachings of the prior art of record nor provides motivation for combining the prior art of record. Applicants submit that claim 41 is allowable over the prior art for at least these reasons.

Turning to the last independent claim, amended claim 42 recites in a computer network, a method comprising defining a plurality of unique sets differentiated by operational capability, editing at least one set to add at least one controlled computing device to the set, storing the set, and at the controller, using the set to control each controlled computing device of the set.

The Office action rejected claim 42 as unpatentable over Rabinovich in view of Mangipudi. Specifically, the Office action contends that Rabinovich teaches

editing at least one set to add at least one controlled computing device to the set, storing the set, and at the controller, using the set to control each controlled computing device of the set. Column 2, lines 65-67, column 4, lines 45-50, and column 5, lines 4-8 of Rabinovich are referenced.

The Office action recognizes that Rabinovich does not teach a plurality of unique sets. However, as was the case with regard to claim 1 and others, the Office action contends that Mangipudi does teach a plurality of unique sets, even though replicated servers cannot be considered unique in this context, and certainly are not differentiated by operational capability. The Office action concludes that the recitations of claim 42 would have been obvious to a person skilled in the art at the time the invention was made because Mangipudi's plurality of sets would improve the system of Rabinovich. Applicants respectfully disagree.

Applicants submit that the Office action has again failed to establish a *prima facie* case for obviousness. As was the case described above, the cited and applied references represent a mismatch of prior art with little correlation to each other, from which the Office action merely picked out phrases as examples for a failed obviousness argument. More specifically with regard to claim 42, the cited and applied references do not teach applicants' invention as claimed. Instead of considering all of the words of claim 42, the Office action impermissibly relies on phrases from applicants' teachings and recitations in order to stitch together phrases from various references to allege the obviousness rejection.

In addition to the reasons discussed above regarding claims 1 and 17, applicants submit that the prior art of record fails to teach or suggest defining a

plurality of unique sets. Rabinovich certainly only teaches a single set of resources that may be organized and maintained by a resource manage and Mangipudi teaches replicated server farms. There is no prior art of record that teaches or even suggest unique sets differentiated by operational capability. Applicants submit that claim 42 is allowable over the prior art of record for at least these reasons.

Applicants respectfully submit that dependent claims 43-48, by similar analysis, are allowable. Each of these claims depends either directly or indirectly from claim 42 and consequently includes the recitations of independent claim 42. As discussed above, Rabinovich and Mangipudi, whether considered alone or in any permissible combination at law, fail to teach or suggest the recitations of claim 42. Even when additional prior art is introduced, such as with Jindal, the prior art of record still fails to teach or suggest the recitations of these claims. Therefore, these claims are also allowable over the prior art of record. In addition to the recitations of claim 42 noted above, each of these dependent claims includes additional patentable elements.

For at least these additional reasons, applicants submit that all the claims are patentable over the prior art of record. Reconsideration and withdrawal of the rejections in the Office action is respectfully requested and early allowance of this application is earnestly solicited.

CONCLUSION

In view of the foregoing remarks, it is respectfully submitted that claims 1-48 are patentable over the prior art of record, and that the application is in good and proper form for allowance. A favorable action on the part of the Examiner is earnestly solicited.

If in the opinion of the Examiner a telephone conference would expedite the prosecution of the subject application, the Examiner is invited to call the undersigned attorney at (425) 836-3030.

Respectfully submitted,

Albert S. Michalik, Reg. No. 37,395
Attorney for Applicants
Law Offices of Albert S. Michalik, PLLC
704 - 228th Avenue NE, Suite 193
Sammamish, WA 98074
(425) 836-3030
(425) 836-8957 (facsimile)

In re Application of SUTTON et al.
Serial No. 10/075,633

CERTIFICATE OF FACSIMILE TRANSMISSION

I hereby certify that this Amendment, along with transmittal and facsimile cover sheet, are being transmitted by facsimile to the United States Patent and Trademark Office in accordance with 37 C.F.R. 1.6(d) on the date shown below:

Date: July 18, 2006

Albert S. Michalik

2970 3rd Amendment